

Patent

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#5

In re Application of:  
Rakib et al.

Art Unit: unknown

Serial No. 09/214,158

Examiner: Unknown

I.A. Filing Date: 12/23/98

I.A. Appl. No. PCT/US97/03984

RECEIVED  
DOCKET: TER-004-2005  
DIRECTOR OFFICE  
TECHNOLOGY CENTER 2000

For: DATA TRANSMISSION USING ATM OVER HYBRID FIBER COAX

Assistant Commissioner  
of Patents and Trademarks  
Box PCT  
Washington, D.C. 20231

Morgan Hill, California

April 24, 2000

RECEIVED  
20 JUN 2000  
U.S. Patent and  
Trademark Office  
Washington, D.C.

ATTN: PCT LEGAL OFFICE

**TRANSMITTAL LETTER FOR PETITION TO WITHDRAW HOLDING OF  
ABANDONMENT UNDER 37 CFR 1.181(a) (OR UNDER 37 CFR 1.137(b) IN  
THE ALTERNATIVE) AND TO ACCEPT THE APPLICATION WITHOUT THE  
SIGNATURE OF INVENTOR FUHRMANN UNDER 37 CFR 1.47(a)**

Dear Sir:

Enclosed herewith is:

1. A combined Petition To Withdraw Holding Of Abandonment Under 37 Cfr 1.181(A)  
(Or Under 37 Cfr 1.137(B) In The Alternative) And To Accept The Application Without  
The Signature Of Inventor Fuhrmann Under 37 Cfr 1.47(A)
2. A Declaration of Ronald Craig Fish in support of the petition of item 1 accompanied by  
Exhibits A through U.

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3. A check for \$130 for the petition to accept the application without signature of all the inventors assuming it is revived. The Commissioner is authorized to charge the petition fee of \$605 to deposit account 06-0932 in the event the Commissioner deems it necessary to treat the petition to withdraw the holding of abandonment as a petition to revive.

Respectfully submitted,

Dated: April 24, 2000



Ronald Craig Fish  
Reg. No. 28,843  
Tel 408 778 3624  
FAX 408 776 0426

I hereby certify that this correspondance is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to:  
Commissioner of Patents and Trademarks, Washington D.C. 20231  
on 4/24/2000  
(Date Of Deposit)

  
Ronald Craig Fish  
Reg. No. 28,843

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:  
Rakib et al.

Art Unit: unknown

Examiner: Unknown

Serial No. 09/214,158

DOCKET = TER-004-2P

I.A. Filing Date: 12/23/98

I.A. Appl. No. PCT/US97/03984

For: **DATA TRANSMISSION USING ATM OVER HYBRID FIBER COAX**

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Assistant Commissioner  
of Patents and Trademarks  
Box PCT  
Washington, D.C. 20231

Morgan Hill, California

April 24, 2000

**ATTN: PCT LEGAL OFFICE**

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 CFR**

**1.181(a) (OR UNDER 37 CFR 1.137(b) IN THE ALTERNATIVE) AND TO**

**ACCEPT THE APPLICATION WITHOUT THE SIGNATURE OF INVENTOR**

**FUHRMANN UNDER 37 CFR 1.47(a)**

Dear Sir:

In connection with the entry of the national stage in the U.S. of the above identified patent application based upon International Application Number PCT/US97/03984 having International Filing Date of 12 March 1997, and in response to a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 USC 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE mailed 8/3/99 and in further response to a DECISION in response to our PETITION UNDER 37 CFR 1.47 TO ACCEPT THE NATIONAL

STAGE APPLICATION WITHOUT THE SIGNATURE OF ONE OF THE INVENTORS, the undersigned hereby petitions as follows.

The undersigned petitions under 37 CFR 1.181(a) to withdraw the holding of abandonment by the petition's attorney Anthony Smith for the reasons and authorities stated below. Those reasons and authorities support the position of the undersigned that the U.S. stage application is not really abandoned on grounds. The undersigned respectfully takes this position on grounds that there is a bona fide disagreement as to the controlling dates upon which the national stage fee needed to be paid. This disagreement caused by an anomalous and unjust situation created by PCT rule 90<sup>bis</sup>.3. This rule allows a priority claim to be withdrawn within 20 months of the priority date, but it does not provide any apparent mechanism to extend deadlines that have already passed to the new deadline created by dropping the priority claim in a multiple priority claim case.

As part of this petition to withdraw the holding of abandonment (in case the Commissioner holds this case really is abandoned and can be only revived by a petition under 37 CFR 1.137(b)) and as a reply to the PCT/DO/EO/917 NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 USC 371..., the undersigned also petitions under 37 CFR 1.47(a) to accept the above identified national stage application in the U.S. and award it a filing date without the signature of Inventor Fuhrmann. Inventor Fuhrmann has refused to join in the application and is refusing to respond to requests for his signature on the Declaration for Patent Application and has been given a copy of the specification, drawings and claims on three separate occasions. Enclosed is a Declaration of Ronald Craig Fish proving the facts pertinent to this situation. Mr. Fuhrmann's last

known address was 444 Saratoga Avenue, #15G, Santa Clara, California 95050.

Also enclosed is a check for \$130 for the petition fee required under 37 CFR 1.17(i) for a petition under 37 CFR 1.47(a). According to 37 CFR 1.181(a) and MPEP 711.03(c), no fee is due on a petition under 37 CFR 1.181(a) to invoke the supervisory authority of the commissioner.

**However, should the Commissioner hold that the U.S. national stage case is actually abandoned and can only be revived by a petition under 37 CFR 1.137(b), the Commissioner is respectfully requested to treat this as a petition under 37 CFR 1.137(b) to revive the U.S. national stage application, and to so notify the undersigned by telephone at 408 778 3624 and to deduct the petition fee of \$605 from deposit account 06-0932 of the undersigned. A duplicate copy of this sheet is enclosed.**

#### **THE FACTS**

The pertinent facts supporting the petitions under 37 CFR 1.181 (a) (or, alternatively, under 37 CFR 1.137(b)) and under 37 CFR 1.47(a) are given in the attached Declaration of Ronald Craig Fish with supporting documentary exhibits. The facts given include facts regarding how the EPO reacted to the sequence of events by first withdrawing the EPO national case, and then upon learning the fact that the undersigned had withdrawn the earliest priority date under PCT Rule 90<sup>bis</sup>.3, reinstated the case and gave the applicants additional time to enter the national stage. The applicants elected not to enter the national stage in the EPO because of the anticipated high translation expenses upon issuance and a change in direction of the engineering effort.

However, the applicants still desire U.S. coverage, and how the EPO reacted after learning the facts despite the fact that the Chapter II demand was technically late is believed to be relevant given the anomalous situation created by PCT Rule 90<sup>bis</sup>.3(a) versus PCT Rule 90<sup>bis</sup>.3(d) which allows a priority claim to be withdrawn within 20 months of the priority date but which will not excuse the need for a Chapter II demand to be made by the end of the 19th month if the withdrawal is filed after the end of the 19th month but before the end of the 20th month of the withdrawn priority date.

### **THE ARGUMENT**

This petition under 37 CFR 1.181(a) to withdraw the holding of abandonment should be granted in the interest of justice and fair play since the applicant withdrew the earliest priority date and only unintentionally failed to pay the U.S. national filing fee by the Article 22 20 month deadline from the withdrawn priority date thinking that the U.S. national stage application was still alive when technically, it was not by operation of PCT Rule 90<sup>bis</sup>.3(d) and the timing of the filing of the Chapter II demand.

The U.S. application was abandoned unintentionally based upon a misunderstanding of how PCT Rule 90<sup>bis</sup>.3 works and a mistake in assuming that if the earliest priority date was withdrawn, a Chapter II demand filed after the 19th month from the dropped date but before the 20th month from the dropped date was timely.

PCT Rule 90<sup>bis</sup>.3(d) creates an anomaly in the situation that occurred here that renders the rule ineffective for its major purpose. PCT Rule 90<sup>bis</sup>.3(a) states:

- (a) The applicant may withdraw a priority claim, made in the international application under Article 8(1), at any time prior to the expiration of 20 months from the priority date or, where Article 39(1)

applies, 30 months from the priority date.

However, PCT Rule 90<sup>bis</sup>.3(d) states:

- (d) Where the withdrawal of a priority claim causes a change in the priority date, any time limit which is computed from the original priority date and which has not already expired shall, subject to paragraph (e), be computed from the priority date resulting from that change.

However, PCT Article 39 (1)(a) states:

If the election of any Contracting State has been effected prior to the expiration of the 19th month from the priority date, the provisions of Article 22 shall not apply to such State and the applicant shall furnish a copy of the international application ... not later than 30 months from the priority date.

Thus, if the withdrawal of the earliest priority claim occurs between the 19th month and the 20th month, and a Chapter II demand has not been made by the end of the 19th month, PCT Rule 90<sup>bis</sup>.3(a) is rendered ineffective for one of its purposes which is to extend the date by which the national phase must be entered. This was probably not intended by the drafters of these complex rules, and works an injustice to applicants who get caught in this trap. It is my opinion that most patent practitioners in the U.S. do not know this anomaly even exists.

In fairness, the undersigned respectfully requests the to withdraw the holding of abandonment in light of the anomalous interaction between PCT Article 39 and PCT Rule 90<sup>bis</sup>.3(d). The PCT body of law is complex and not terribly well understood by most practitioners. It seems unfair to maintain this case in an abandoned state when the

USPTO itself treated the case and not abandoned and kept the Chapter II demand fees and the U.S. national filing fees.

Further, 35 USC 371(d) provides for some Commissioner discretion on the due date for the U.S. national filing fee. That statute provides:

(d) The requirements with respect to the national fee referred to in subsection (c)(1) ... shall be complied with by the date of commencement of the national stage **or by such later time as may be fixed by the Commissioner.**

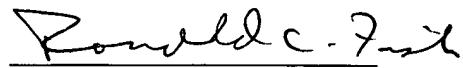
Under this provision of the statute, it would be acceptable for the Commissioner to deem the U.S. national filing fee due when the the U.S. national stage application was actually filed. This would be a legal and appropriate thing to do to alleviate the injustice caused by the anomaly in the interplay between PCT Article 39(1)(a) setting a 19 month deadline from the priority date to make a Chapter II demand and PCT Rule 90<sup>bis</sup>.3(d) and PCT Rule 90<sup>bis</sup>.3(a) which allow the priority claim to be withdrawn but which do not extend any deadlines already passed. It seems fair to do this since otherwise there is a one month interval between the 19 month and the 20 month from the dropped priority date when PCT Rule 90<sup>bis</sup>.3(a) is completely ineffective. If the priority claim is dropped during the interval, but the Chapter II demand is not made before the 19th month, PCT Rule 90<sup>bis</sup>.3(a) fails of its essential purpose to allow extension of the deadlines caused by the dropped priority date.

The situation is even more unjust when one considers the fact that the applicants could have filed a U.S. application on the earliest priority date of 14 mar 1996 and then filed a CIP on the PCT International Application date of 12 Mar 1997 claiming priority

to the 14 Mar 1996 date. The applicants could have then filed a continuation of the CIP on 15 Nov 1997 and they would not have had to pay the filing fee on 15 November 1997 and could have extended the due date for the filing fee for several months after the notice of missing parts was received. Thus, to maintain the U.S. national stage case in a state of abandonment would be unjust to the applicants just because they elected to avail themselves of the PCT route.

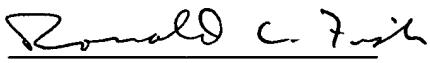
Respectfully submitted,

Dated: April 24, 2000



Ronald Craig Fish  
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on 4/24/2000  
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Ronald Craig Fish  
Reg. No. 28,843